

## **REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration of this application and reconsideration of the Office Action dated May 23, 2006.

### **I. General Remarks Regarding the Content of this Amendment**

Upon entry of this Amendment, claims 1-11, 17-28 and 30-37 will remain pending in this application. Claims 1 and 17 have been amended to recite receiving user input via a computer indicating a purchase date in the past for the portfolio. Support for these changes is readily evident from original claims 1 and 17. No substantive changes have been presented.

No new matter is included in this Amendment, and no additional claim fees are due as a result of this Amendment.

#### *Examiner Interview*

Applicants thank Examiner Poinvil for the courtesies extended to Applicants' representative, Elizabeth Almeter, in the Interview of July 12, 2006. During the interview, the publication date of cited reference "Mutual Fund Investors Center" [www.mfea.com](http://www.mfea.com) was discussed. The Examiner indicated that he would attempt to determine a more definite publication date for the reference. In addition, a proposed amendment to claim 1 was discussed. The amendment included modifying the language to indicate that the purchase date for the portfolio was in the past. Although agreement was not reached, the Examiner indicated his belief that this amendment may clarify the scope of the claim. The substance of the arguments presented in the Interview are presented below.

### **II. Claim Rejections Under 35 U.S.C. § 102**

In the Office Action, the Office rejected claims 1-2, 5 and 17-18 under 35 U.S.C. § 102(b) as allegedly anticipated by "Mutual Fund Investor's Center" [www.mfea.com](http://www.mfea.com) (hereinafter

“MFEA”). See the Office Action at pages 2-3. Applicants respectfully traverse this rejection and request reconsideration.

Applicants respectfully assert that the Office has not provided sufficient evidence to show that the cited reference pre-dates the application filing date. The Office notes the 1996-2006 copyright date included in the reference as appropriate evidence of the date. However, Applicants assert that the Office has produced absolutely no evidence to demonstrate that the website [www.mfea.com](http://www.mfea.com) existed in its current form prior to the filing date of this application, namely June 13, 2000. Accordingly, the Office has not carried its burden of establishing that MFEA anticipates any of Applicants’ claims. Withdrawal of this rejection is respectfully requested.

This asserted rejection also fails on its merits. To anticipate a claim, the cited reference must teach each and every element of the claim. Moreover, the identical invention must be disclosed in as complete detail as is contained in the claim, and the various claimed elements must be arranged in the same manner as required by the claim. See *The Manual of Patent Examining Procedure*, § 2131 and the cases cited therein. As will be demonstrated below, MFEA clearly fails to anticipate Applicants’ claimed invention.

Applicants’ claim 1 recites a computer-implemented method for creating a portfolio of issues. This method includes: (a) receiving user input via a computer identifying specific issues to be added to the portfolio; (b) receiving user input via a computer indicating a selection of one of a plurality of options for creating a portfolio; (c) receiving user input via a computer indicating a *purchase date in the past* for the portfolio; and (d) creating the portfolio and *calculating the portfolio’s past performance*, using a computer, based on said selection of one of said plurality of options and the past date. MFEA does not teach or suggest this claimed method.

More specifically, MFEA describes a method of identifying mutual funds that meet desired investment criteria. See MFEA at page 2. The “Fund Selector” described in MFEA allows a user to input various criteria to then identify funds that meet those criteria. Such criteria

include account type, fees and expenses, fund performance, load, minimum required investment amount Morningstar rating, etc. Once the criteria have been selected, the Fund Selector then identifies various funds that meet these criteria. The user may then choose to create a portfolio of those funds. *Id.* at page 4-5.

The method described in MFEA does not include an option to select a purchase date in the past for any funds. In addition, MFEA does not calculate the past performance of the funds from a user specified past date. Rather, the Fund Selector of MFEA simply identifies funds that meet a certain criteria. Accordingly, Applicants respectfully submit that even if it were available as prior art against the present application, MFEA fails to anticipate the invention as defined in amended claim 1. In addition, dependent claims 2 and 5 should be allowed for at least the reasons cited for claim 1.

Independent claim 17 has been amended to include language similar to amended claim 1. Accordingly, claim 17 and claim 18 that depends from claim 17 are allowable for at least the reasons cited for claim 1.

### **III. Claim Rejections Under 35 U.S.C. § 103**

Claims 3, 4, 6-11, 19-28 and 30-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over MFEA in view U.S. Patent No. 5,978,778, hereinafter “O’Shaughnessy.” This rejection is respectfully traversed for at least the following reasons.

In order to establish a *prima facie* case of obviousness under § 103(a), three criteria must be met: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706 .02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

As indicated above, Applicants respectfully assert that the Office has failed to carry its burden of establishing that MFEA is a validly available reference against the present application because there is a lack of evidence showing that MFEA pre-dates the instant application in its cited form.

In addition, claim 28 recites a system for creating a portfolio of issues including (a) an input system for receiving a designation of issues from a user, for receiving a designation of an option from a user for creating said portfolio selected from a plurality of options, and for receiving a historical price associated with each of said issues; and (b) a processor for determining the number of shares of said issues to add to said portfolio and past performance data relating to the portfolio based on said designated option and said historical price. MFEA, in combination with O'Shaughnessy, does not teach or suggest this claimed system.

As discussed above, MFEA does not teach or suggest use of a historical price. O'Shaughnessy does not cure this deficiency. The Office cites column 14, lines 22-59 of O'Shaughnessy as showing a historical price associated with each of the issues. Applicants respectfully disagree. Rather, O'Shaughnessy simply describes a method of creating a portfolio in which stocks are selected based on various criteria such as earnings gains, price-to-sales ratios, etc. O'Shaughnessy does not teach or suggest receiving a *historical price* for each of the issues, nor does it teach determining the number of shares to add to the portfolio based on the historical price. For at least this reason, Applicants respectfully assert that claim 28 is allowable.

Claims 30 and 34 recite receiving identification of a past closing date for the issues from a user and receiving historical prices for the specific issues based on the past closing date. Neither MFEA or O'Shaughnessy teach or suggest the identification of a specific *past closing date* or receiving historical prices based on that *past closing date*. Accordingly, Applicants respectfully submit that claims 30 and 34 are allowable.

Finally, dependent claims 3-4, 6-11, 19-27, 31-33 and 35-37 are allowable for all of the reasons discussed above concerning their respective base claims, and further in view of the additional inventive features recited in each of those claims.

#### **IV. Conclusion**

If the Examiner believes that a telephone conference or a personal interview will be useful to advance the prosecution of this application and/or place the application in condition for allowance, he is invited to contact the undersigned attorney by telephone.

Applicants believe that no fees are due to enable entry and consideration of this Amendment. If, however, the Office determines that any fees are required, such as fees under 37 C.F.R. §§ 1.16 or 1.17, or if an extension of time is necessary that is not accounted for in the papers filed with this Amendment, the Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees, including any necessary extension fees or other fees needed to maintain the pendency of this application.

All rejections having been addressed, Applicants respectfully submit that this application is in condition for immediate allowance and respectfully solicit prompt notification of the same.

Respectfully submitted,  
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